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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,914	03/06/2002	Yasuteru Takahama	02138/LH	9197

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,914

Applicant(s)

TAKAHAMA, YASUTERU

Examiner

Thong Q. Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: .

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings contain four sheets of figures 1-8 were received on May 6, 2002.

These drawings are objected by the examiner for the following reason(s).

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See present specification in pages 9-12. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities: a) Page 7: lines 15-20, the brief description of figures 2 and 3 are unclear. It is noted that the structure of the inverted microscope shown in the two figures have different components/arrangements; however, the differences are not stated in the brief descriptions of the figures; b) Page 7, lines 24-27 and page 8: lines 1-2, the brief

description of figures 5 and 6 are unclear for the similar reason as set forth in element a) above; c) Page 8: lines 3-9, the brief description of figures 7 and 8 are unclear for the similar reason as set forth in element a) above; d) Page 16: line 2, "23" should be changed to -53—(see page 15, line 22, for example); e) Page 18: lines 3 and 5, "23" should be changed to -53--; f) Page 22: line 22, "V-shaped and V-shaped" should be changed to -V-shaped and U-shaped— (See figure 4). There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 7 is indefinite because the feature "the optical element" (line 2) lacks a proper antecedent basis. Applicant should note that the feature relating to the optical element is recited in claim 3, not claim 2.

b) Claim 9 is indefinite because it depends upon itself.

c) Each of claims 10 and 13 is indefinite for the same reason as set forth in element a) above.

d) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiencies thereof.

Double Patenting

8. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claim 5/4/3/2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

10. Claim 6/5/4/3 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

11. Claim 8/7/2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

12. Claim 11/10/2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

13. Claim 14/13/2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 2. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims –6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al (U.S. Patent No. 6,160,662) in view of Meyer et al (U.S. Patent No. 5,235,459).

Uchida et al disclose a microscope having an illuminating system. The microscope as described in columns 2 and 4-7 and shown in figures 1-4 comprises a main housing (10) supporting a stage (21) whose height with respect to the base (10) is variable; a revolver (71) supporting a plurality of

objective lens; a focusing mechanism for adjusting the space between the revolver and the sample supported by the stage for the purpose of adjusting the focus; a set of optical elements including lens elements for forming an intermediate image of the sample. The illuminating system comprises a light source and optics for guiding light to illuminate the sample wherein the illuminating system is able to remove from the main body of the microscope. The microscope also comprises an additional system attached to the main body of the microscope wherein the additional system comprises an observation tube supporting a plurality of optical elements which includes at least one lens element (42) which is in combination with the lens element (13) located inside the base of the microscope for forming a relay lens system. The only feature missing from the art of Uchida et al is that it does not explicitly state that the additional system is removably attached to the main body of the microscope wherein the system comprises an optical element for splitting a part of the light beam to an image pickup device.

However, the use of an observation system having at least one lens of a relay lens system and a splitting element for splitting a part of light to an image pickup device wherein the observation system is able to removable attach to the main body of a microscope is known to one skilled in the art as can be seen in the microscope provided by Meyer et al. See columns 4-5 and figs. 1-2 and 6-7, for instance. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the microscope provided by Uchida et al by

using an observation system having at least one tube for supporting a part of relay lens system and a splitting element as suggested by Meyer et al for the purpose of providing a means for guiding the image of a sample to a pickup device.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additional references are cited as of interest in that 1) each of the U.S. Patent Nos. 6,097,538 and 4,770,520 discloses a removably observation device having a tube connected to the main body of a microscope wherein the tube supporting a set of lens elements and a splitting element; 2) each of the U.S. Patent Nos. 5,015,081 and 4,337,991 discloses a microscope system having optical elements and/or housing supporting a plurality of optical elements wherein the optical element(s) and/or the housing is able to removably attached to the main body of a microscope.

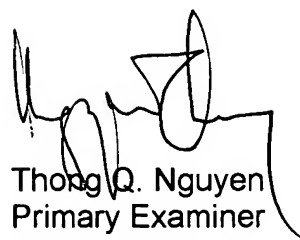
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

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Thong Q. Nguyen
Primary Examiner
Art Unit 2872
